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The time period for reply, if any, is set in the attached communication.

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AREN'T FOX LLP
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SUITE 400
WASHINGTON, DC 20036

In re Application of:
Christelle et al.
Serial No.: 10/539,406 : PETITION DECISION
Filed: November 23, 2005 :
Attorney Docket No.: 021305-00214 :
:

This is in response to the petition filed July 14, 2008 under 37 CFR § 1.181, requesting that the finding of non-responsiveness by the examiner as communicated in the letters of March 14, 2008 and June 19, 2008 be overturned in favor of applicants and that the Request for Continued Examination filed on January 8, 2008 along with the arguments presented therein be fully considered by the Examiner.

BACKGROUND

More recently, the examiner mailed a final Office action August 8, 2007. In this Office action, *inter alia*, the examiner instituted a rejection of claims 6-13 under 35 U.S.C. § 112, first paragraph, for lacking written description and further maintained the rejection of claims 8-11 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention and maintained the rejection of claims 1-3 and 5-8 under 35 U.S.C. 103§ (a).

On November 8, 2007, in reply to the final Office action of August 8, 2007, applicants submitted remarks and arguments after final Office action under 37 C.F.R. § 1.116.

On December 4, 2007 the examiner mailed an Advisory Action which indicated that applicants' arguments submitted with the remarks of November 8, 2008 were not sufficient to overcome the outstanding rejections.

On January 8, 2008 Applicants filed a proper Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 with the appropriate fees.

On March 14, 2008, the examiner mailed a Non-Responsive letter to applicants. In this letter, the examiner explained that while the receipt of the RCE and fee for RCE submission was acknowledged, the RCE was "...not fully responsive to the prior Office action because the Remarks and Amendments do not address the 35 U.S.C. § 112 1st paragraph rejection of Claims 6-13 as failing to comply with the written description requirement with regard to New Matter or the rejection of Claims 8-11 under 35 U.S.C. § 112, 2nd paragraph for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention..."

On June 19, 2008 the examiner issued an additional Non-Responsive letter to applicants, essentially reiterating the reasons for non-responsiveness set forth in the Non-Responsive letter of March 14, 2008.

In response thereto, applicants filed this petition on July 14, 2008 under 37 CFR § 1.181, requesting that the finding of non-responsiveness by the Examiner as communicated in the letter of March 14, 2008 be overturned in favor of Applicants and that the Request for Continued Examination filed on January 8, 2008 along with the arguments presented therein be fully considered by the Examiner.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed on July 14, 2008, applicants argue that the amendment of January 8, 2008 was improperly denied entry (p. 1, Petition). However, it is pointed out that the amendment of January 8, 2008 which was filed with the RCE of January 8, 2008 has been entered into the case because the RCE filed by applicants was a proper RCE accompanied by the appropriate fees for filing said RCE. The Non-Responsive letters mailed by the examiner indicated that the response filed with the RCE of January 8, 2008 was non-responsive, but did not indicate that the RCE or the papers filed therewith would not be entered.

Applicants argue that they request relief from the examiner's refusal to resume prosecution of this case. Presumably, it is taken that applicants traverse the Non-responsive letters of March 13, 2008 and June 19, 2008 mailed by the examiner which indicated that the response filed with the RCE of January 8, 2008 was not sufficient to respond to the outstanding rejections made under 35 U.S.C. § 112, first and second paragraphs, as set forth in the final Office action mailed by the examiner on August 8, 2007.

Applicants specifically point out that the amendment submitted with the RCE of January 8, 2008 contained a reference to applicants' previous remarks set forth in the remarks filed by applicants on November 8, 2007 and May 17, 2007:

On January 8, 2008, Applicants submitted a further response to the August 8, 2007 Office Action along with an RCE and a Petition for Extension of Time. This Amendment Submitted with RCE was not a required submission. It was merely a supplemental amendment filed to make further claim amendments to enhance the value of the previously-submitted arguments in response to the prior art rejections. Applicants incorporated by reference the comments set forth in their fully-responsive November 8, 2007 Amendment

After Final Rejection. Applicants expected that because the November 8, 2007 response to the August 8, 2007 Office Action was entered, the supplemental response filed on January 8, 2008 would also be entered, as evidenced by the statement found on the first page of the Amendment Submitted with RCE, "Further to the Amendment After Final Rejection filed on November 8, 2007, please amend the application as shown on the following pages," and the statement found in the Remarks section, "*Applicants refer the Examiner to the remarks contained in the Amendments filed on May 17, 2007 and November 8, 2007.*" In the Notice dated March 14, 2008, the Amendment filed on January 8, 2008 was considered non-responsive for failing to address the rejection of claims 6-13 under 35 U.S.C. § 112, first paragraph, for alleged lack of written description, and the rejection of claims 8-11 under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. This March 14, 2008 Notice was clearly issued in error, as the Amendment Submitted with RCE under 37 C.F.R. § 1.114 that was filed on January 8, 2008 was not the first or only submission in response to the Office Action dated August 8, 2007. Rather, the January 8, 2008 Amendment was supplemental to the Amendment After Final Rejection under 37 C.F.R. § 1.116 that was submitted on November 8, 2007, which was entered and considered by the Examiner. As noted above, it incorporated by reference all of Applicants' previous comments in response to those rejections. (pp. 2-5, Petition)

The specific statement in the remarks filed with the RCE of January 8, 2008 recites:

Applicants respectfully request that the outstanding rejections under 35 U.S.C. § 112 and 103 be withdrawn in view of the amendments and remarks submitted to date in this application. Applicants refer the Examiner to the remarks contained in the Amendments filed on May 17, 2007 and November 8, 2007. (p. 5, Remarks of January 8, 2008)

37 C.F.R. 1.111 (b) states:

In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

Applicants' statement made in the remarks filed with the RCE of January 8, 2008 as reiterated above, merely incorporates their remarks made on May 17, 2007 and November 8, 2007 into the remarks filed with the RCE on January 8, 2008. Applicants' response of May 17, 2007 includes, *inter alia*, a traversal of the examiner's rejection of claims 6-12 under 35 U.S.C. § 112, second paragraph, as well as a traversal of the examiner's rejection of claims 1-8 and 12 under 35 U.S.C. § 103(a). Applicants' response of November 8, 2007 includes a traversal of all of the rejections instituted by the examiner in the final Office action mailed on August 8, 2007 including a traversal of the examiner's rejection of claims 6-13 under 35 U.S.C. § 112 First paragraph (see pages 4-5 of the remarks of November 11, 2007), a traversal of the examiner's rejection of claims 8-11 under 35 U.S.C. § 112, second paragraph (see pages 5-6 of the remarks of November 8, 2007), as well as a traversal of the examiner's rejection of claims 1-3 and 5-8 under 35 U.S.C.

§ 103(a) (see pages 6-12 of the remarks of November 8, 2007). Hence, applicants' statement made in the response filed with the RCE which specifically refers the examiner to the remarks contained in the amendments of May 17, 2007 and November 8, 2007 is sufficient to respond to the outstanding rejections made in the final Office action mailed by the examiner on August 8, 2007 because the responses by applicants on May 17, 2007 and November 8, 2007, together, specifically respond to every outstanding rejection instituted by the examiner in the final Office action of August 8, 2007.

Applicants are required to fully respond to the outstanding rejections of record per the requirements set forth under 37 C.F.R. 1.114. It is decided that Applicants' response filed with the RCE of January 8, 2008 is fully responsive because the response satisfies the provisions of 37 C.F.R. 1.114 by specifically responding to each individual rejection set forth by the examiner in the final Office action mailed on August 8, 2007. It is noted that applicants are not precluded from submitting arguments in traversal of rejections whereby those arguments were already previously submitted by applicants and subsequently considered by the examiner.

Considering that applicants' response as filed with the RCE of January 8, 2008 was responsive to the final Office action of August 8, 2007, the Non-responsive letters mailed by the examiner on March 14, 2008 and June 19, 2008 are hereby vacated.

DECISION

The petition is **GRANTED**.

This application will be forwarded to the examiner to act on the RCE filed on January 8, 2008 and to consider applicants' arguments presented therein, whether the arguments are presented specifically in the remarks filed with the RCE, or presented therein by incorporation.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



Irem Yucel
Director, Technology Center 1600